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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,843	01/15/2004	Mike A. Clark	PHOE-0188	5090

23377 7590 10/10/2006
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EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
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1657

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,843

Applicant(s)

CLARK, MIKE A.

Examiner

David M. Naff

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1651

DETAILED ACTION

A response of 7/19/06 to a restriction requirement of 6/19/06 amended claim 31, added new claims 36-38 dependent on Group III claims, and elected Group III claims 25-34 and 36-38 with traverse.

5 The traverse is persuasive, and Groups I-IV will be examined.

Claims examined on the merits are 23-38, which are all claims in the application.

Claim Objections

10 Claim 24 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 23. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

15 The only difference in the methods of claims 23 and 24 is the preamble, and the preambles do not change the method steps claimed. Enhancing circulating half-life in the preamble of claim 23 will be inherent when enhancing tumoricidal activity in the preamble of claim 24, and enhancing tumoricidal activity in claim 24 will be inherent
20 when enhancing circulating half-life in claim 23. It is suggested claim 23 be deleted.

Claim Objections

Claim 35 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 25. When two claims in an application are
25 duplicates or else are so close in content that they both cover the

Art Unit: 1651

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only difference in the methods of the claims is in the preambles. Treating a tumor as in the preamble of claim 25 will be inherent when treating and inhibiting metastases in the preamble of claim 35, and treating and inhibiting metastases in claim 35 will be inherent when treating a tumor in claim 25. It is suggested claim 35 be deleted.

10 ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

15 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23 and 24 are confusing by requiring the same methods except for the preamble of claim 23 requiring enhancing circulating half-life, and the preamble of claim 34 requiring enhancing tumoricidal activity. It is not seen how the same method can enhance circulating half-life without enhancing tumoricidal activity, or the converse. Similarly, it is not seen how the method of claim 25 that has the same steps as the method of claim 35 can treat a tumor and not

Art Unit: 1651

treat and inhibit metastases as required by the method of claim 35, or the converse.

Double Patenting

5 The nonstatutory double patenting rejection is based on a
judicially created doctrine grounded in public policy (a policy
reflected in the statute) so as to prevent the unjustified or improper
timewise extension of the "right to exclude" granted by a patent and
to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the
10 conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference
claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See,
e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In*
15 *re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*
Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*,
686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).

20 A timely filed terminal disclaimer in compliance with 37 CFR
1.321(c) or 1.321(d) may be used to overcome an actual or provisional
rejection based on a nonstatutory double patenting ground provided the
conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of
25 activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of
record may sign a terminal disclaimer. A terminal disclaimer signed by
the assignee must fully comply with 37 CFR 3.73(b).

30 Claims 23-38 are rejected on the ground of nonstatutory
obviousness-type double patenting as being unpatentable over claims 1-
14 of U.S. Patent No. 6,737,259 B1. Although the conflicting claims
are not identical, they are not patentably distinct from each other
because the methods of claims 23 and 24 will be inherent when the
35 compound of the patent claims is prepared, and the methods of claims
25-38 are obvious uses of the compound of the patent claims since it
is known to use arginine deiminase for tumor treatment as disclosed in
the present specification in the background.

Double Patenting

Claims 23-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,183,738 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of the present claims would have been obvious from the compound and methods of enhancing circulating half-life and enhancing tumoricidal activity required by the patent claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David M. Naff
Primary Examiner
Art Unit 1651

DMN
9/30/06